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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,114	10/25/2000	Toru Kobayashi	00745/LH	4404
1933	7590	10/01/2003	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 767 THIRD AVENUE 25TH FLOOR NEW YORK, NY 10017-2023			HEWITT II, CALVIN L	
		ART UNIT	PAPER NUMBER	
		3621		

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/696,114	KOBAYASHI ET AL.
	Examiner Calvin L Hewitt II	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 September 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 124-165 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 124-165 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

***Status of Claims***

1. Claims 124-165 have been examined.
2. Applicant's arguments with respect to claims 124-165 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 150-165 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 150 recites, "job ID information sent from the print service station" in line 3. Claim 151 also recites "job ID information sent from the print service station". There is insufficient antecedent basis for these limitations in their respective claims, because in claim 149 the "job ID information" is not transmitted from the print service station.

Claims 152-165 are also rejected as they depend from claim 151.

5. Claim 164 recites “a cryptographic key for each client” in line 3. There is in  
There is insufficient antecedent basis for this limitations in the claim.

Claims 165 is also rejected as it depends from claim 164.

6. Claims 163-165 are rejected under 35 U.S.C. 112, second paragraph, as  
being indefinite for failing to particularly point out and distinctly claim the subject  
matter which applicant regards as the invention.

Claim 163 recites “the print service station requests a log-in for the data  
service system”. However, to one of ordinary skill a “log-on” requires human  
interaction, such as a user supplying a username or ID, and password.

Claims 164 and 165 are also rejected as they depend from claim 163.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35  
U.S.C. 102 that form the basis for the rejections under this section made in this  
Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by  
another filed in the United States before the invention by the applicant for patent or (2) a patent  
granted on an application for patent by another filed in the United States before the invention by the  
applicant for patent, except that an international application filed under the treaty defined in section  
351(a) shall have the effects for purposes of this subsection of an application filed in the United States  
only if the international application designated the United States and was published under Article 21(2)  
of such treaty in the English language.

8. Claims 142 and 147-152 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Stefik et al. by U.S. Patent No. 6,233,684.

As per claims 142 and 147-152 Stefik et al. teach a print system for use through a network comprising:

- a data service system, with a communication section, connected to a network having a storage section in which a plurality of data (e.g. book data) are stored in a plurality of data storing locations and a calculating section to calculate a payment to be charged in accordance with the printing result (abstract; figures 1, 2 and 5; column 5, lines 35-40)
- a plurality of printer service stations connected to the network comprising: input for inputting a print specification of a customer to print an ordered book from the data storage location and printing the book data (figure 16; column 5, lines 35-40; column 6, lines 1-28; column 8, lines 3-38)
- a data processing section for compiling the image data in accordance with the specification, the print section printing in accordance with the specification, and a book copying system for determining a charge for the ordered book based on the print specification (figure 16; column 5, lines 35-40; column 6, lines 1-28; column 8, lines 3-38; column 9, lines 13-63)

- transmitting order signal from customer to the data service system and the data service system (e.g. data managing section) transmitting job ID information and image data on the basis of the job ID information to the printer station in response to the order (figures 5-7; column 8, lines 25-38)
- transmitting stored estimated payment information (e.g. relating to royalties, service charge for providing image data) to the customer, by the service system and the customer indicating a payment on the basis of the payment information (e.g. calculating a copy charge) (abstract; figures 6 and 7; column 5, lines 7-10; column 9, lines 14-60; column 13, lines 10-19)
- a data managing section transmitting a data storing location (e.g. the file, watermark) to the print section (column 8, lines 5-38)

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 124-140, 141, and 143-146 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684.

As per claims 124-140, 141 and 143-146; Stefik et al. teach a print system for use through a network comprising:

- a service system, with a communication section, connected to a network having a storage section in which a plurality of data are stored in a plurality of data storing locations and a calculating section to calculate a payment to be charged in accordance with the printing result (abstract; figures 1, 2 and 5)
- a printer service station in connection with the service system, to order and produce a copy of a digital work (e.g. book) (figures 3 and 5; column 5, lines 35-40; column 7, lines 10-20)

Regarding charges by the data service system and print service station. The data service system charges users for accessing the digital work (figure 6). Stefik et al. also disclose a “print store” (figure 16) that is distinct and separate from the user workstation, as well as the data service system, hence it is at least obvious that the “print store” would charge a fee for providing print services, such as for making use of (e.g. renting) materials such as printers, computers...etc.

Regarding charge reduction, coupons and “volume discounts” are well known to those of order skill of retail management.

Stefik et al. also teach:

- a communicating system notifying the service system of the printing result by the client system (column 13, lines 10-19)
- a printer client system with a finishing section, print failure detection section that indicates a success or failure of image formation and transmits an indicator of the result, and charges payment on the basis of successful printing(s) (column 13, lines 10-19)
- a plurality of printers and setting a print charge for each of the plurality of printers (figure 16)
- calculating a payment to be charged in accordance with the printing result (column 13, lines 10-19)
- Stefik et al. teach calculating a charge at the data service system (column 13, lines 10-19; column 15, lines 53-65). Similarly, a store that provides data printing services comprises a calculating section that calculates a charge for making use of said services (figure 16). Therefore, it would have been obvious to integrate the charge calculation function such that it exists at either or both facilities for efficiency or security (if the publisher finds the remote print system lacking- figure 16, column 17, lines 7-10). Regarding copyright fees,

- it would have been obvious to one of ordinary skill to not apply copyright fees if copyright fees didn't apply, for example, in the event the copyright has terminated.

As per claims 143-146, Stefik et al. teach service charges that are valid for a period of time (column 5, lines 47-59). Stefik et al. also teach a "print store" (figure 16). Therefore, it is at least obvious that a print store employee can quote an end-user an estimated cost for making use of the print store's services. Stefik et al. teach transmitting stored estimated payment information (e.g. relating to royalties, service charge for providing image data) to the client system, by the service system (e.g. data server, master server) and the client system indicating a payment on the basis of the payment information (e.g. calculating a copy charge) (abstract; figures 6 and 7; column 5, lines 7-10; column 9, lines 14-60; column 13, lines 10-19) Stefik et al. teach calculating a charge at the data service system (column 13, lines 10-19; column 15, lines 53-65). Similarly, a store that provides data printing services comprises a calculating section that calculates a charge for making use of said services (figure 16). Therefore, it would have been obvious to integrate the charge calculation function such that it exists at either or both facilities for efficiency or security (if the publisher finds the remote print system lacking- figure 16, column 17, lines 7-10). Regarding copyright fees, it would have been obvious to one of ordinary skill to not apply copyright fees if

copyright fees didn't apply, for example, in the event the copyright has terminated.

11.       Claims 141 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 in view of Yoshiura et al., U.S. Patent No. 6,131,162.

As per claims 141, Stefik et al. teach a system for secured printing using cryptography (abstract; figures 1, 2 and 5). However, Stefik et al. do not explicitly recite the printer client system applying a digital signature to requested data using public key or other cryptographic scheme. Yoshiura et al. teach a system for securing data where a client system digitally signs requested data using public key cryptography (abstract; figures 2 and 5; column 6, lines 25-34; column 12, lines 12-28). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al. and Yoshiura et al. in order to identify illegal copies of content ('162, abstract; column 3, lines 14-28; column 11, lines 30-48).

12. Claims 153-161 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 in view of Hatrick et al., U.S. Patent No. 5,532,920.

As per claims 153-161 Stefik et al. teach a system for secured printing that allows users to download digital works and compensates creators for the use of their digital works, uses cryptographic communications to exchange data between a remote data service system and a consumer system (abstract; figures 1, 2 and 5-7; column 13, lines 10-19). Claims 153-155 are broad enough to read on mere downloading data from a remote location over a communication network such as the internet. A process that is old and well known. Stefik et al. teach a book copying system comprising:

- encrypting the requested data by the service system and the printer client system downloading the encrypted request data, decrypting the data and conducting printing on the basis of the decrypted data (figure 5)
- encrypting the requested data by the service system and the printer client system downloading the encrypted request data, decrypting the data and conducting printing on the basis of the decrypted data (figure 5)

Stefik et al. also teach notifying the server system of successful printing and processes based on the print result (abstract; figures 1, 2 and 5-7; column 13, lines 10-19). Stefik et al. also teach billing a user after it is verified that successful printing took place (column 13, lines 10-19). Therefore, to one of ordinary skill it would have been obvious to consider unsuccessful attempts as "trial" printing and not to adjust the charge so as to not charge a user for an unsuccessful copy attempt (e.g. charging based on the printing result). Similarly, it would have been obvious for the "print store" (figure 16) to maintain such a policy regarding defective printing. However, Stefik et al. do not specifically recite book printing or page unit basis. On the other hand, Stefik et al. apply their system to document printing (column 13, lines 43-45). Hence, a user has the ability to print a one page or multi-page document and select the frequency for printing each page (figure 12). Hartick et al. teach a system for compensating content creators for the right to access digital works on a book or chapter basis (abstract; figures 9A-11; column 12, lines 8-20) and a service system that changes a page arrangement order in accordance with a processing capability of the printer client system such as a selected access mode (e.g. chapter or book) (column 12, lines 8-20). In addition, it would have been obvious to one of ordinary skill to not apply copyright fees if the copyright has terminated. Therefore, it would have been obvious to one of ordinary skill to combine the systems of Stefik et al. and Hartick et al. in order to provide a user with the ability to access portions of a digital work

as opposed to accessing the entire work ('684, abstract; '920, figure 11; column 12, lines 9-18).

13.       Claims 160-162 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 and Hartick et al., U.S. Patent No. 5,532,920, as applied to claim 159 and in further view of Yoshiura et al., U.S. Patent No. 6,131,162.

As per claims 160-162, Stefik et al. teach a system for secured printing that allows users to download digital works and compensates creators for the use of their digital works (abstract; figures 1, 2 and 5-7). Hartick et al. teach a system for compensating content creators for the right to access digital works on a book or chapter basis (abstract; figures 9A-11; column 12, lines 8-20) and a service system that changes a page arrangement order in accordance with a processing capability of the printer client system such as a selected access mode (e.g. chapter or book) (column 12, lines 8-20). However, neither Stefik et al. nor Hartick et al. explicitly recite digital signatures. Yoshiura et al. teach a system for securing data where a client system digitally signs requested data using public key cryptography (abstract; figures 2 and 5; column 6, lines 25-34; column 12, lines 12-28). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al., Hartick et al. and Yoshiura et al. in order to further secure the system ('684, figure 1) by incorporating the ability to identify

illegal copies of content ('162, abstract; column 3, lines 14-28; column 11, lines 30-48).

14. Claims 163 and 165 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 in view of Servi, U.S. Patent No. 5,278,904.

As per claims 163 and 165, Stefik et al. teach a system for secured printing that allows users to download digital works and compensates creators for the use of their digital works (abstract; figures 1, 2 and 5-7). However, Stefik et al. do not teach logging on to a server. Servi et al. teach a system for verifying a requester comprising a client system logging on to a server and the server certifying the log-on request (figure 1; column 1, lines 12-33; column/line 2/40-3/2). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al. and Servi in order to prevent unwanted access to the system.

15. Claim 164 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 and Servi, U.S. Patent No. 5,278,904, as applied to claim 163 and in further view of Yoshiura et al., U.S. Patent No. 6,131,162.

As per claim 164, Stefik et al. teach a system for secured printing that allows users to download digital works and compensates creators for the use of their digital works (abstract; figures 1, 2 and 5-7). Servi et al. teach a system for verifying a requester comprising a client system logging on to a server and the server certifying the log-on request (figure 1; column 1, lines 12-33; column/line 2/40-3/2). However, neither reference teaches digital signatures. Yoshiura et al. teach a system for securing data where a client system digitally signs requested data using public key cryptography (abstract; figures 2 and 5; column 6, lines 25-34; column 12, lines 12-28). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al., Servi et al. and Yoshiura et al. in order to further secure the system ('684, figure 1) by incorporating the ability to identify illegal copies of content ('162, abstract; column 3, lines 14-28; column 11, lines 30-48).

### ***Conclusion***

16.        Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
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or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II  
September 30, 2003

JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600